

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Stavrianopoulos et al.)
Serial No.: 07/967,646)
Filing Date: October 28, 1992)
For: COMPOSITION AND KIT EMPLOYING)
CHEMICALLY-LABELLED POLYNUCLEOTIDE)
PROBES)

Art Unit: Not Yet Known
Examiner: Not Yet Known
Prior Art Unit: 1807
Previous Examiner:
Dr Ardin Marschel

December 4, 1992
New York, New York

FILED IN PERSON

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

ATTENTION: **OFFICE OF THE ASSISTANT COMMISSIONER
FOR PATENTS
2121 CRYSTAL DRIVE - CRYSTAL PARK 2
SUITE 913
ARLINGTON, VIRGINIA 22202**

**PETITION
UNDER 37 C.F.R. §1.60(b)**

Dear Sir:

Applicants, through their attorney, are filing this Petition Under 37 C.F.R. §1.60(b), which is directed to the attention of the Office of the Assistant Commissioner for Patents, in order to obtain a filing date in the above-identified application (hereinafter "the subject application").

The subject application was filed as a continuation under 37 C.F.R. §1.60 of U.S. Application Serial No. 07/607,347, filed on October 30, 1990 (hereinafter "the parent application"). In turn, the parent application was filed as a continuation application of U.S. Application Serial No. 07/385,986, filed on July 20, 1989 (hereinafter "the grandparent application"). The grandparent issued as U.S. Patent No. 4,994,373 on February 19, 1991 (hereinafter "the '373 patent"). The grandparent application is a continuation of U.S. Application Serial No. 06/732,374, filed on May 9, 1985, abandoned (hereinafter "the great-grandparent application"), which is a continuation-in-part of U.S. Application Serial No. 06/461,469, filed on January 21, 1983 (hereinafter "the great-great grandparent application"), also abandoned.

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On November 24, 1992, the Application Branch issued a "Notice of Incomplete Application Filed Pursuant to 37 CFR 1.60." Attached to this Petition as Exhibit 1 is the copy of the Notice.

In the Notice of Incomplete Application Filed Pursuant to 37 CFR 1.60 (Exhibit 1), the Application Branch indicated that:

"[a] filing date has NOT been assigned since 37 CFR 1.60 has not been complied with for the reason(s) indicated below:

2. A copy of the oath or declaration filed in the parent application is missing."

In order to obtain the October 28, 1992 filing date for the subject application which is necessary because the parent application was revived for the purpose of filing the former under Rule 1.60, Applicants, through their attorney, are filing with the Assistant Commissioner for Patents, this Petition under 37 C.F.R. §1.60(b). Before outlining the facts and events necessitating this Petition, Applicants' undersigned attorney would like to point out that this Petition is being filed under 37 C.F.R. §1.60(b) as a result of a telephone conversation with Mr. John Gonzales, Office of the Assistant Commissioner for Patents (Tel. 703-305-9384). After being briefed on this matter, Mr. Gonzales was helpful in noting that the correct rule provision for this Petition is 1.60(b).

Applicants' attorney has examined the file copy and acknowledges the astuteness of the Application Branch in observing that the original declaration (from the great-grandparent application) was missing from the October 28, 1992 filing. Normally, it would be a simple matter of attaching the properly executed declaration; however, in the instant case, the declaration is not without some history and elaborate explanation.

First, there are two declarations in the family. The first declaration was filed in in the first-filed great-great-grandparent application. The second declaration was filed in the great-grandparent application, that application having been filed as a continuation-in-part of the first-filed application in the family. In reviewing the files for the great-grandparent application, it appears that one of the inventors did not want to sign the second declaration, resulting in a Notice to File Missing Parts of Application-Filing Date Granted that was mailed on June 4, 1985.

In response to the Notice and pursuant to 37 C.F.R. §1.47(a), Applicants' previous attorney (Mary E. Bak) prepared and filed on September 12, 1985 an Affidavit with supporting documents attached thereto as Exhibits A-H. Attached to this Petition as Exhibit 2 is a copy of the signed Affidavit of Mary E. Bak with supporting Exhibits A-H, although the copy of the affiant's signature is very faint, even on Applicants' file copy. It is respectfully noted that the September 12, 1985 papers included both the first and second declarations, which, therefore, are also being submitted with this Petition. The first Declaration was attached as Exhibit A (also attached hereto as Exhibit A) and the second Declaration was submitted in a paper entitled "LETTER." For the convenience of the petitioner examiner, an exhibit tab marked "X" has been inserted to mark the second Declaration.

On December 12, 1985, the Office of the Assistant Commissioner for Patents issued a Decision Accepting Papers Filed Under 37 C.F.R. §1.47(a), and authorizing the Application Division to accept the application as a 37 C.F.R. §1.47(a) application and to mail a Filing Receipt with a filing date of May 9, 1985. A copy of the December 12, 1985 Decision is also attached to this Petition as Exhibit 3.

In filing the continuation request for the instant application, the undersigned provided a copy of the specification and original claims, as well as other supporting documents, including previous powers of attorney and the recorded assignments. Because Serial No. 07/385,986 (which issued as the '373 patent) was filed as a file wrapper continuation under 37 C.F.R. §1.62, no declaration was present in the grandparent file, contributing no doubt to the inadvertent and unfortunate omission of the declarations in the instant application.

Applicants respectfully request that the Office of the Assistant Commissioner for Patents pass favorably on this Petition, by authorizing the Application Division to accept the two declarations submitted herewith and to mail a Filing Receipt for the subject application with an October 28, 1992 filing date.

The Patent and Trademark Office is hereby authorized to charge Deposit Account No. 05-1135 for the requisite fee of \$130.00 U.S. Dollars (Fee Code 122 - Revised Patent and Trademark Fees Effective October 1, 1992). The Patent and Trademark Office is further authorized hereby to charge Deposit Account No. 05-1135 for any fees required in connection with this Petition and to credit any overpayment thereto. A duplicate copy of this Petition is enclosed.

Finally, Applicants and their attorney sincerely regret any inconvenience to the Patent Office, including the Application Branch and the Assistant Commissioner, that has resulted from their October 28, 1992 filing.

In order to expedite review, Applicants' undersigned attorney has arranged for their Washington associates to file in person both copies of this Petition Under 37 C.F.R. §1.60(b), including the attached exhibits [1-2 (A-H & X) and 3) with the Office of the Deputy Assistant Commissioner for Patents.

Favorable action on this Petition is courteously solicited.

Respectfully submitted,



Ronald C. Fedus, Esq.
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Attorney for Applicants

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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07/967,646 10/28/92 STAVRIANOPOULOS

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RONALD C. FEDUS
ENZO BIOCHEM. INC.
60 EXECUTIVE BLVD.
FARMINGDALE, NY 11735

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DATE MAILED: 11/24/92

**Notice of Incomplete Application Filed Pursuant to
37 CFR 1.60**

A filing date has NOT been assigned since 37 CFR 1.60 has not been complied with for the reason(s) indicated below:

1. A copy of the specification (description and claims) filed in the parent application:
 - a. is missing.
 - b. has page(s) _____ missing.
 - c. has the description of the invention missing.
 - d. has claim(s) _____ missing.
2. A copy of the oath or declaration filed in the parent application is missing.
3. The copy of the oath or declaration filed does not show applicant(s) signature or an indication on the oath or declaration that it was signed.
4. A copy of the drawings as filed in the parent application is missing.
5. A copy of any amendments referred to in the oath or declaration filed to complete the parent application is missing.
6. A statement that the application papers filed are a true copy of the prior application and that no amendments referred to in the oath or declaration filed to complete the prior application introduced new matter therein is missing. Such statement must be by the applicant or applicant's attorney or agent and must be a verified statement if made by a person not registered to practice before the United States Patent and Trademark Office.
7. Other:

\$130.00

The filing date will be the date of receipt of the items required above unless otherwise indicated. Any assertions that the items required above were submitted or are not necessary for a filing date must be by way of a petition directed to the attention of the Office of the Assistant Commissioner for Patents. Any such petition must be accompanied by the \$140.00 petition fee (37 CFR 1.17(h)). If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

All of the above-noted omissions must be submitted within TWO MONTHS of the date of this notice or the application will be returned upon request or otherwise disposed of.

Direct the response to, and questions about, this notice to the undersigned, Attention: Application Branch, and include the above Serial Number and Receipt Date.

R. Hackney /PD
For: Manager, Application Branch
(703) 557-508-1202